



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

08/953,477

10/17/1997

SALIM G. KARA

45923-P012US

3876

29053

7590

08/31/2006

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/953,477

Applicant(s)

KARA ET AL.

Examiner

Joseph R. Pokrzywa

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-74 and 90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-63, 65, 66, 70, 74 and 90 is/are rejected.
- 7) ☒ Claim(s) 64, 67-69 and 71-73 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 2-4, filed 5/4/06, with respect to the rejection(s) of claim(s) 57 under 35 U.S.C.102(e) as being anticipated by Kaufeld (U.S. Patent Number 5,859,967) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Manduley (U.S. Patent Number 5,648,916).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 57-63, 65, 66, 70, and 74** are rejected under 35 U.S.C. 102(e) as being anticipated by Manduley (U.S. Patent Number 5,648,916).

Regarding **claim 57**, Manduley discloses a system for delivering information to a selected location from a transmitting location (see abstract, and column 1, lines 46-59, and column 2, line 4-column 3, line 57), the system comprising a transmission station operable at the transmitting location (mail room 11) and adapted to transmit the information to an intermediate location (see Figs. 1 and 2, column 2, line 4-column 3, line 15), and an intermediate station operable at the

Art Unit: 2625

intermediate location (building 30, see Figs. 1 and 2) and adapted to receive the information transmitted by the transmitting station (column 2, line 4-column 3, line 15), wherein the intermediate station (building 30) comprises a converter circuit (scanners 20 and 25 and computers 17 and 18) adapted to electronically receive the transmitted information and to convert the transmission to electronic form if the transmitted information is not initially in electronic form (see abstract, and column 2, lines 20-51), and a reproducing circuit (printer and mail metering and processing equipment 26 and 27) adapted to reproduce the information in human readable form (column 2, lines 52-67), wherein the reproducing circuit also produces an indicia of payment authorizing delivery of the human readable information to the selected location (column 2, lines 52-67).

Regarding **claim 58**, Manduley discloses the system discussed above in claim 57, and further teaches of the intermediate location being selected according to proximity to the selected location (column 1, lines 5-58, column 2, line 20-column 3, line 15, being inherent in the mail delivery system of Figs. 1 and 2).

Regarding **claim 59**, Manduley discloses the system discussed above in claim 58, and further teaches of the intermediate location selection is accomplished automatically by the transmitting location through reference to address information with respect to the selected location (column 1, lines 5-58, column 2, line 20-column 3, line 15, being inherent in the mail delivery system of Figs. 1 and 2).

Regarding **claim 60**, Manduley discloses the system discussed above in claim 57, and further teaches of the intermediate location is selected according to proximity to the transmitting

Art Unit: 2625

location (column 1, lines 5-58, column 2, line 20-column 3, line 15, being inherent in the mail delivery system of Figs. 1 and 2).

Regarding **claim 61**, Manduley discloses the system discussed above in claim 57, and further teaches of the converter circuit comprises circuitry adapted to accept electronic documents communicated utilizing different communication protocols (column 2, lines 4-51).

Regarding **claim 62**, Manduley discloses the system discussed above in claim 61, and further teaches of the different communication protocols include at least two protocols selected from the group consisting of a standardized electronic mail communication protocol (column 2, lines 4-67), a special purpose mail communication protocol, a standardized facsimile protocol (column 2, lines 4-67), a standardized character based protocol, and a standardized packet based protocol.

Regarding **claim 63**, Manduley discloses the system discussed above in claim 57, and further teaches of the converter circuit comprising circuitry adapted to determine delivery address information with respect to the selected location from information contained within the transmitted information (column 2, line 20-column 3, line 57).

Regarding **claim 65**, Manduley discloses the system discussed above in claim 57, and further teaches of a means for including ancillary information with the transmitted information (column 2, lines 42-67), wherein the ancillary information being suitable for use by the receiving means in delivery of the transmitted information to the selected location (column 2, lines 42-67).

Regarding **claim 66**, Manduley discloses the system discussed above in claim 65, and further teaches of the ancillary information comprising means for funding delivery of the transmitted information (column 2, lines 52-67).

Regarding **claim 70**, Manduley discloses the system discussed above in claim 65, and further teaches of the ancillary information includes a delivery address of the selected location (column 2, lines 20-67).

Regarding **claim 74**, Manduley discloses the system discussed above in claim 57, and further teaches of the reproducing circuit is operable at least in part with corresponding circuitry disposed at the selected location (column 2, line 42-column 3, line 5).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 90** is rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley (U.S. Patent Number 5,648,916) in view of Kaufeld (U.S. Patent Number 5,859,967, cited in the Office action dated 1/17/06).

Regarding **claim 90**, Manduley discloses the system discussed above in claim 57, but fails to expressly disclose if the intermediate station further comprising an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information. Kaufeld discloses a system for delivering information to a selected location from a transmitting location (see abstract, Fig. 1, and column 3, lines 10-65), the system comprising a transmission station operable at the transmitting location (local computer 30) and adapted to transmit the information to an intermediate location (column 3, lines 10-46), and an intermediate station operable at the

Art Unit: 2625

intermediate location (computer 26) and adapted to receive the information transmitted by the transmitting station (column 3, line 31-column 4, line 28). Further, Kaufeld teaches that the intermediate station further comprising an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (see Fig. 7, column 7, lines 25-34, and column 8, line 57-column 9, line 21).

Manduley & Kaufeld are combinable because they are from the same field of endeavor, being systems that transmit received data to desired location. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to utilize the acknowledgment circuit taught by Kaufeld within the system of Manduley. The suggestion/motivation for doing so would have been that Manduley's system would become more user-friendly with the addition of Kaufeld's teachings, as the mail sender would have knowledge of when the message was sent or if an error occurred, as recognized by Kaufeld in column 7, lines 25-34. Therefore, it would have been obvious to combine the teachings of Kaufeld with the system of Manduley to obtain the invention as specified in claim 90.

Allowable Subject Matter

6. **Claims 64, 67-69, and 71-73** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2625

jrp


JOSEPH R. POKRZYWA
PRIMARY EXAMINER